

## REMARKS

This paper is filed in response to the Office Action mailed on March 9, 2005. Currently, Claims 29-35 and 37-41 are pending in the application. Claims 29-33, 35, and 37-41 have been examined and stand rejected. Claim 34 is objected to. Reconsideration of Claims 29-33, 35, and 37-41 is respectfully requested.

### The Rejection of Claim 29 Under 35 U.S.C. § 102(b)

Claim 29 is rejected under 35 U.S.C. § 102(b) as being anticipated by Belogour (U.S. Patent No. 5,503,413).

Claim 29 has been amended to recite, "wherein the frame is balanced to prevent substantial biasing of the frame towards the base and away from the base."

Belogour appears to describe an in-line skate with a suspension system at the heel of the boot. The toe of the boot is attached to the front part of the wheel frame assembly at an axis about which the boot appears to pivot. The weight of the heel of the shoe rests on a spring that biases the heel upward. The suspension spring allows the frame and heel to move in relation to each other to dampen out bumps in the riding surface.

As now amended, Claim 29 encompasses a skate wherein the skate frame is balanced to prevent substantial biasing of the frame towards the base and away from the base. Without limitation, such balancing can be achieved by providing opposing springs on either side of the pivoting point, or by creating friction at the pivoting point so that any pivoting movement may require a nominal amount of force to overcome the friction.

Belogour teaches that the shoe base is biased away from the frame. Please see Column 5, lines 13-18.

For a reference to be anticipatory, the reference must exactly describe the claimed invention. Because Belogour does not describe wherein the frame is balanced to prevent

substantial biasing of the frame towards the base and away from the base, the reference is not anticipatory. Accordingly, the withdrawal of the rejection of Claim 29 is respectfully requested.

The Rejection of Claims 35, 37, 38, 40, and 41 Under 35 U.S.C. § 102(e)

Claims 35, 37, 38, 40, and 41 are rejected under 35 U.S.C. § 102(e) as being anticipated by Svensson et al. (U.S. Patent No. 6,120,040). Applicant respectfully disagrees.

Claim 35 recites having a base, "wherein the base is neutrally biased." Neutrally biased may mean that the base flexing region produces little to no upward biasing of the frame against the base. Little to no upward biasing means that the base is intentionally constructed having about zero flex strength, or stated another way, bias is substantially reduced by selection of a resilient base material with little spring force, such as leather, or that is reduced in thickness at least at the point of flexion, such as a thermoplastic base that is transversely grooved on the underside of the base. Please see the instant specification on page 25, lines 15-32.

In direct contrast to Claim 35, Svensson et al. describes a biasing member to bias the heel of the base and the frame together. See the Abstract. See also Column 9, lines 26-30. Svensson describes, "the flexing skate 10 of the present invention preferably includes a biasing member to urge the base 14 downwardly to the lower or unflexed configuration of Figure 1, and away from the upper or flexed configuration of Figure 2. Preferably, this biasing is provided by a spring incorporated into the base 14 that is co-planar with the base 14."

The invention defined by Claim 35 is an advancement over Svensson in that Claim 35 requires a flexible base to be neutrally balanced that is intended to neither forcefully bias the frame and shoe base together or allow free movement. Thus, without having to fight against the force of the spring, the skater using the skate defined by Claim 35 may expend less energy in plantarflextion.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

For a reference to be anticipatory, the reference must exactly describe the claimed invention. Because Svensson does not teach or suggest a base, wherein the base is neutrally biased, the reference is not anticipatory. Accordingly, the withdrawal of the rejection of Claims 35, 37, 38, 40, and 41 is respectfully requested.

The Rejection of Claim 30 Under 35 U.S.C. § 103(a)

Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Belogour (U.S. Patent No. 5,503,413) in view of Chang (U.S. Patent No. 5,842,706).

As now amended, Claim 30 recites, "wherein the base flexes at a metatarsal region."

A *prima facie* case of obviousness requires a suggestion or motivation, either in the references or in the knowledge generally available to modify a reference or to combine references, there must be a reasonable expectation of success, and all the claimed limitations must be taught or suggested by the prior art.

Belogour appears to describe a rigid sole plate 12 that is inflexible. The only pivoting of the shoe with respect to the frame appears to occur at the pivoting point 42.

Chang describes a somewhat similar concept in that a spring 3 biases the boot upward with respect to the truck (frame) by extension of the compressed spring member. See Column 2, lines 21-23. However, neither Belogour nor Chang teach or remotely suggest a flexible base, wherein the base flexes at a metatarsal region.

Applicant submits a proper *prima facie* case of obviousness requires the prior art references to teach or suggest every limitation of the claims. Neither Belogour nor Chang teach or remotely suggest "wherein the base flexes at a metatarsal region."

Accordingly, the withdrawal of the rejection of Claim 30 is respectfully requested.

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

The Rejection of Claims 31 and 32 Under 35 U.S.C. § 103(a)

Claims 31 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Belogour (U.S. Patent No. 5,503,413) and Chang (U.S. Patent No. 5,842,706) as applied to Claim 30 above, and further in view of Svensson et al. (U.S. Patent No. 6,120,040).

Claim 31, recites, "the base further comprises a heel region and forefoot region, the base being adapted to flex at a metatarsal region at the forefoot region during skating and wherein the frame is secured to an underside of the forefoot region of the base." Claim 32 is dependent from Claim 31.

The indication by the Examiner that neither Belogour nor Chang disclose the base being adapted to flex at a metatarsal region is appreciated. The Examiner states that "it would have been obvious to a person of ordinary skill in this art to allow the base disclosed in Belogour to be adapted to flex at a metatarsal region of the forefoot during skating as taught by Svensson et al. The motivation for doing so would have been to allow the heel portion of base to pivot more freely in relation to the forefoot of the base."

For a proper *prima facie* case of obviousness, first, there must be a motivation or suggestion to modify or combine references, and there must be a reasonable expectation of success. It is well established that the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness, and the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. Furthermore, it is well settled that the modification of the prior art invention cannot result in either rendering the prior art unsatisfactory for its intended purpose or even changing the principle of its operation.

Belogour appears to have a rigid plate that underlies the sole of the shoe. This fact alone renders the prior art invention unsuitable to be modified. Furthermore, there is a purpose for

having a rigid base plate underlying the sole. Belogour is related to skate suspension system. In order for the suspension system to function properly, the shoe must be in continuous contact with the suspension system. Otherwise, if the heel of the boot is not in contact with the suspension system, the object of the suspension system is defeated. Applicant submits that modification of Belogour to have a flexible base only defeats the purpose of the suspension system, since the boot would no longer be in contact with the spring as the heel flexes upward. Furthermore, the mechanical constraints of Belogour prevents any such modification. Figures 4 and 10 of Belogour clearly shows that the heel of the boot is "locked" at the end of its travel. Thus, only enabling a limited range of movement. As can be readily appreciated, the modification of Belogour to pivot at the metatarsal region would defeat the purpose of the suspension system, and would also require a substantial change to its operation, so much so that Belogour would be rendered inoperable for its intended purpose. For obviousness, there must be some suggestion or motivation, and any modification must be expected to be reasonably successful. Neither a proper motivation nor a reasonable expectation have been shown. Therefore, Belogour, either alone or in combination with Chang and Svensson, does not render Claim 31 obvious.

Accordingly, the withdrawal of the rejection of Claims 31 and 32 is respectfully requested.

The Rejection of Claim 33 Under 35 U.S.C. § 103(a)

Claim 33 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Belogour (U.S. Patent No. 5,503,413), Chang (U.S. Patent No. 5,842,706), and Svensson et al. (U.S. Patent No. 6,120,040) as applied to Claims 30-32 above, and further in view of Chang (U.S. Patent No. 6,053,512).

LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

Claim 33 is ultimately dependent from Claim 30, which is submitted is allowable over the cited and applied references. Chang (6,053,512) does not cure the deficiencies with Belogour, Chang (5,842,706), and Svensson.

Accordingly, the withdrawal of the rejection of Claim 33 is respectfully requested.

The Rejection of Claim 39 Under 35 U.S.C. § 103(a)

Claim 39 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Svensson et al. (U.S. Patent No. 6,120,040) in view of the Examiner's Official Notice.

Claim 39 is dependent from Claim 35, which is submitted is allowable over the cited and applied references. The Examiner takes Official Notice that it is notoriously old and well known that skate bases have been made from leather. Applicant respectfully traverses the Examiner's statement of Official Notice. Applicant respectfully submits that none of the claims defines well known subject matter. Furthermore, not even the Official Notice cures the improper *prima facie* case for obviousness.

Accordingly, the withdrawal of the rejection of Claim 39 is respectfully requested.

The Allowed Claim 34

Applicant acknowledges with appreciation, the indication of allowable subject matter in Claim 34.

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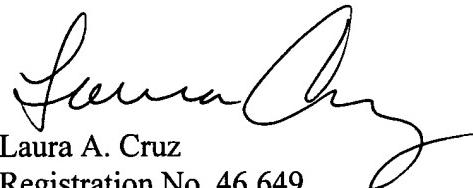
LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

## CONCLUSION

In view of the foregoing amendments and remarks, applicant respectfully submit that Claims 29-35, and 37-41 are allowable. If the Examiner has any further questions or comments, the Examiner may contact the applicant's attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



Laura A. Cruz  
Registration No. 46,649  
Direct Dial No. 206.695.1725

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June 9, 2005

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LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100